

## REMARKS

This Response is submitted in reply to the Office Action mailed January 15, 2008. Claims 1, 8, 10, 18, 19, 25, 88 and 108 to 110 have been amended. No new matter has been added by way of these amendments.

A Petition for a Two-Month Extension of Time is submitted herewith. Please charge deposit account No. 02-1818 for the cost of the extension of time and any other fees due in connection with this Response.

The Office Action rejected:

1. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement;
2. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 6,193,606 to Walker ("Walker") in view of the teachings of Vancura, Martinez or Kilby;
3. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 103 as being unpatentable over U.K. Patent No. 2,262,642 to Claypole et al. ("Claypole") in view of the teachings of Vancura, Martinez or Kilby; and
4. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 5,848,932 to Adams ("Adams") in view of Walker and further in view of the teachings of Vancura, Martinez or Kilby.

### **1. The §112 Rejections**

The Office Action alleges "in the independent claims 'a first outcome displayed to the player' and 'a second outcome displayed to the player' fail to comply with the written description requirement." Applicant submits that the support for these elements can at least be found on page 19 line 1 to page 22 line 31, on page 23 line 24 to page 24 line 26, on page 26, lines 1 to 26 and on page 37 lines 21 to 24. It is inherent that an "underlying casino game of chance" such as slots, joker poker, live card games, dice, wheel games, etc... "according to the rules of the game" results in the display of one or

more outcomes such as slot symbols, cards, numbers on dice or an indicated symbol on a wheel. A second outcome is displayed to the player in the knowledge based bonus game.

The Office Action alleges that in Claim 88 "a plurality of first outcomes" fails to comply with the written description requirement. Applicant submits that the support for these elements can at least be found on page 37 lines 23 to 30 and on page 38 lines 1 to 25. These sections of the application disclose that the game of chance can be any conventional casino game such as "slots, joker poker, live card games, dice, wheel games, etc." In all of these games one or plurality of outcomes are displayed to players of these games. For example, in a slot game a plurality of symbols on a plurality of paylines are displayed to players.

The Office Action alleges that in Claims 8 and 10 "wherein at least one of said minimum value and said maximum value are configured to change for different plays of the knowledge based bonus game" is not disclosed and that in Claims 117, 120 and 121 "[v]alues 'configured to change for different plays of the knowledge based bonus games'" are not disclosed. Applicant submits that the support for these elements can at least be found on page 12 lines 20 to 28. Additionally, throughout the specification the different formulas disclosed (such as the formulas disclosed on page 14) include taking into account the wager made by the player. Therefore, the minimum and maximum amounts would change per play of the game depending on the amount wagered per player.

The Office Action states that it rejects Claim 3, 9, 24, 30, 89 to 116, and 118 to 122. However, the Office Action fails to specifically state how these claims fail to comply with the written description requirement. Applicant submits that the Office Action has not met its burden in rejecting these claims because it fails to set forth express findings of fact which support the lack of written description. "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of

evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97." MPEP 2163.04. In rejecting a claim for failing to comply with the written description requirement, "the Office Action must set forth express findings of fact which support the lack of written description conclusion (see MPEP § 2163 for examination guidelines pertaining to the written description requirement). These findings should:(A) Identify the claim limitation(s) at issue; and (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed." The Office Action does not state any findings or reasoning in rejecting Claim 3, 9, 24, 30, 89 to 116, and 118 to 122.

Applicant requests that the rejections of Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 be withdrawn because Applicant has either pointed to supporting disclosure in the specification or the rejections were not proper.

## **2. The rejections over Walker in view of the teachings of Vancura, Martinez or Kilby**

Walker discloses a gaming system that enables a player to play a game of knowledge, such as a trivia game, while playing a slot game on a slot machine. The player can use successful trivia results to access higher reward levels with the slot game, with each reward level having progressively higher payouts for a given winning combination or a higher probability of a winning result. The trivia questions are stored in a question database after being obtained from a remote source.

More specifically, the Walker gaming system includes a plurality of gaming machines, a probability table and a plurality of paytables. The probability table includes each possible reel combination and number ranges assigned to each possible reel combination. The different paytables are associated with different reward levels which are determined by predefined criteria. The gaming system monitors a player's trivia question performance to determine the player's payable for the slot game. If the player meets certain predefined criteria, the gaming system moves the player up a reward level. For example, every time the player answers three correct trivia questions, the

player moves up a reward level and thus a different payable.

In a play of the game, a player presses a spin reels button. The gaming system generates a number via a random number generator. The gaming system determines the current reward level based on the player's trivia results and looks up the number on the appropriate probability table to determine a reel combination. The gaming system causes the reels to spin and to stop spinning to generate and display the determined reel combination. While the reels are spinning, the gaming system provides the player a trivia question. Based on the identified slot outcome and the player's answer to the trivia question, the gaming system locates the appropriate payable and determines a single award for the player. The single award in Walker is dependent on the randomly generated outcome for the slot game and additionally dependent on the trivia game.

For example, the Walker gaming system randomly generates a number and matches the number on the probability table to a symbol combination of bar/plum/plum. A first payable provides an award of 14 for not answering the trivia question, an award of 18 for a correct trivia answer and an award of 12 for an incorrect trivia answer. A second payable provides an award of 14 for not answering the trivia question, an award of 20 for a correct trivia answer and an award of 12 for an incorrect trivia answer. The payable used in determining the outcome for the player is based on the player's reward level.

Vancura, Martinez and Kilby are publications disclosing the general concept of a house advantage in gaming. More specifically, the Office Action uses Vancura to support the allegation that a casino does not want to lose money.

The Office Action relies on Kilby to support the allegation that player skill level is probability the most significant determinant of hold.

The Office Action relies on Martinez to disclose the house percentage fluctuates depending upon the skill of the player. Martinez states that the house advantage of "blackjack fluctuates between .5 and 4 percent on average depending on the skill of the player." The Office Action also uses Martinez to support the allegation that "[o]ne consideration is the player skill as discussed above, not only to make sure that the house does not loose money, but also to make sure they do 'not pummel the clientele, and they will not return nor will anyone else visit after the word gets out.'"

Claim 1 includes displaying a play of an underlying game of chance which results in a first outcome displayed to the player. The first outcome is dependent upon at least one random determination and is capable of resulting in a first payout to the player. The underlying game of chance has a first house advantage. Claim 1 also includes displaying a play of a knowledge-based bonus game using answers inputted by the player in combination with the underlying game of chance. The play of the knowledge-based bonus game results in a second outcome displayed to the player and dependent upon the knowledge of the player. The second outcome is capable of resulting in a second payout to the player. Claim 1 also includes, if the first outcome results in the first payout, the first payout is provided to the player even if the second payout is not provided to the player and if the second outcome results in the second payout, the second payout is provided to the player even if the first payout is not provided to the player.

Neither Walker, Vancura, Martinez nor Kilby render obvious this combination of elements. Specifically, neither Walker, Vancura, Martinez nor Kilby render obvious two separate payoffs available to the player.

The Office Action states that “[w]hile applicant points to comments made by the Board as Walker not teaching two payoff[s], such is considered unpersuasive since his claims do not explicitly recite two payoffs.” Applicant disagrees with this statement. The claims include a first outcome capable of resulting in a first payout and a second outcome capable of resulting in a second payout. The first payout and the second payout are two payoffs. The claims have also been clarified to include if the first outcome results in the first payout, providing the first payout to the player even if the second payout is not provided to the player and if the second outcome results in the second payout, providing the second payout to the player even if the first payout is not provided to the player. Walker does not render obvious two payoffs.

The Office Action states “[w]here appellant cites the Board Decision stating the ‘Walker teaches a single payoff’; he does not state in the context in which the Board made this statement.” Applicant disagrees with this statement. The Board Decision, Appeal No. 2004-0357, for the parent application Serial No. 09/372,560 (“Board Decision”) states:

While Walker teaches a combination of a slot machine and a trivia game with the ability to access higher rewards (Walker abstract), **we find that Walker does not teach the use of two payoffs as required by the language of all of independent claims.** Walker teaches that the payoff from the game of chance is either raised or reduced based upon a correct or incorrect answer to the trivia question. Therefore, **Walker teaches a single payoff.** Additionally, we find that the spinning of the reels each iteration of the game of chance would not amount to the occurrence of a bonus condition after the game of chance to initiate the game of skill. (emphasis added)

Clearly, the statement that the Board found that Walker does not teach two separate payoffs is not taken out of context. The Board plainly considered the teachings of Walker and found that it does not teach two separate payoffs.

The Office Action proceeds to state “[t]aken at face value, this determination is most broadly incorrect. Walker clearly shows a first payoff 950 and a second payoff 960.” Applicant disagrees with this statement. These two payoffs are not both provided to a single player for a single play of the games. The chart of Fig. 10 provides the player a single award based on the trivia answer and the random determination in the slot game. The first column 950 indicates the award a player receives for not answering a trivia question and the second column 960 indicates the award the player receives for correctly answering that same question. For example, if the player does not answer the trivia question and the gaming machine generates three cherry symbols, the player receives 20 coins. If the player does answer the trivia question and the gaming machine generates three cherry symbols, the player receives 27 coins. The player does not receive both 20 coins and 27 coins because the player cannot not answer the trivia question while correctly answering the same trivia question. Applicant submits that the Office Action is misinterpreting Walker. Additionally, the Office Action is clearly contradicting the Board Decision in making this statement.

The Office Action proceeds to state that:

reels 332, 334 and 336 as shown in fig. 3B are considered to be (form claim 1) ‘displaying a play of an underlying game of chance which results in a first outcome displayed to the player’ on the reels. These reels are a first outcome that is dependent upon the random determination of the spinning reels that is capable of resulting in a first payout to the player. The underlying game of chance has a first house advantage. The play of

the knowledge-[b]ased bonus game is combined with the underlying game of chance as shown in fig. 3B which results in a second outcome dependent upon the knowledge of the player as shown in the tables of figs. 8 to 10 which is capable of resulting in a second payout to the player.

Applicant disagrees with this statement. The trivia game of Walker determines a level or a payable for the slot game. This level is not a payout to the player. In Walker, the determination a payable to use in a game is not determining a specific, separate payout that is provable to the player.

The Office Action states that “[w]hile appellant disagrees with the examiner’s interpretation, it is not a question of whose interpretation of the claim language in view of the prior art is more correct. The question is whether or not the limitations in the claim fairly distinguishes over the art. Since, as set forth by the example of the examiner’s interpretation, this is not the case, the claims stand rejected.” Applicant disagrees with this statement as well. Walker does not disclose or teach what the Office Action claims it is teaching and therefore cannot render the pending claims obvious. Walker specifically teaches only one award provable to a player based on two games.

Applicant submits that Walker teaches away from providing two payoffs or two payouts. “A *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect ‘taught away’ from the claimed invention ... A reference may be said to teach away when a person of ordinary skill, upon reading the reference ... would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (quotations omitted). In Walker, a single payout to a player is determined by two games. One game determines a reward level and another game determines an amount from the reward level to provide to the player. This dual determination of a single award of Walker teaches away from providing two payouts to the player. This dual determination of a single award additionally teaches away from providing a first payout even if a second payout is not provided and providing a second payout even if a first payout is not provided.

Additionally, neither Walker, Vancura, Martinez nor Kilby render obvious, in combination with the other elements of amended Claim 1, the knowledge-based bonus

game is configured to maintain within a predetermined range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, the predetermined range configured to include at least two expected returns for the player, a first expected return provided by the play of the knowledge-based bonus game by the player guessing answers and a second expected return provided by the player having perfect knowledge of answers.

The Office Action states that the Office Action of October 19, 2007 states that the "prior art does not show the play of a game that 'results in a first outcome displayed to a player'" and proceeds to argue against this alleged statement. Applicant disagrees with this statement. The section referred to stated:

Specifically, Claim 1 includes displaying a play of an underlying game of chance which results in a first outcome displayed to the player. The first outcome is dependent upon at least one random determination and is capable of resulting in a first payout to the player. The underlying game of chance has a first house advantage. Claim 1 also includes displaying a play of a knowledge-based bonus game using answers inputted by the player in combination with the underlying game of chance. The play of the knowledge-based bonus game results in a second outcome displayed to the player and dependent upon the knowledge of the player. The second outcome is capable of resulting in a second payout to the player. **Neither Walker, Vancura, Martinez nor Kilby render obvious this combination of elements.** (emphasis added)

Applicant never alleges that Walker does not teach alone that a first outcome may be displayed to a player.

Claims 8, 10, 18, 19, 25 and 88 each include if the first outcome results in the first payout, providing the first payout to the player even if the second payout is not provided to the player and if the second outcome results in the second payout, providing the second payout to the player even if the first payout is not provided to the player.

Applicant submits that for at least the reasons stated above, Claims 1, 8, 10, 18, 19, 25 and 88 and the claims that depend therefrom are patentable over Walker in view of the teachings of Vancura, Martinez or Kilby and are in condition for allowance.

**3. The rejections over Claypole in view of the teachings of Vancura, Martinez or Kilby**

Claypole discloses a gaming machine which has a reel display including three rotatable reels with fruit symbols and a video display screen. Elements of a trail system are progressively illuminable by certain outcomes of a game played on the reels. Sufficient advancement of the illuminable trail elements initiates the display of a video game on a second display screen. In one embodiment, the award for reaching a particular advancement on the trail is a skill game which is played using another display screen. The skill game may be provided as an award based on the reel game. The skill game may be a quiz game providing an award for a correct answer. The skill game may be a shooting game which can provide an award dependent on the player's success in the shooting game.

Page 9 of the Parent Board Decision states:

[w]hile Claypole teaches the use of game of skill, such as a quiz game, (Claypole at pages 3, 4, and 7), Claypole does not specifically address that the outcome of the combination of game of chance and game of skill would have separate payoffs. (Reply brief at pages 14-15.) From our review of the teachings of Claypole, we find no clear discussion that there are two separate payoffs for the two portions of the combined game. The examiner maintains that Claypole teaches the separate payoffs by the discussion of the player using the collect button. (Answer at page 10, Claypole at page 12.) While this shows the ability to collect the winnings from the game of chance, there is no discussion of how the payoff of the trivia or quiz game would be made and what the wager would be.

From our review of the Claypole reference, we find that Claypole is silent as to the payoffs and the house advantage. We find Claypole to be a general teaching of multiple variations on combined games with little detail thereto. ...

The Office Action states that “[a]ppellant states that ‘Clayne does not disclose a first outcome capable of resulting in a first payout’ and quotes the Parent Board Decision. This argument is incorrect.” Applicant disagrees with this statement. Specifically, Applicant stated:

Neither Claypole, Vancura, Martinez nor Kilby render obvious the combination of elements of amended Claim 1. Specifically, Claim 1 includes displaying a play of an underlying game of chance which results in a first outcome displayed to the player. The first outcome is dependent upon at least one random determination and is capable of resulting in a first payout to the player. The underlying game of chance has a first house advantage. Claim 1 also includes displaying a play of a knowledge-based bonus game using answers inputted by the player in combination with the underlying game of chance. The play of the knowledge-based bonus game results in a second outcome displayed to the player and dependent upon the knowledge of the player. The second outcome is capable of resulting in a second payout to the player. Neither Claypole, Vancura, Martinez nor Kilby render obvious this **combination of elements.** (emphasis added)

Applicant did not state that Claypole does not disclose a first payout.

Neither Claypole, Vancura, Martinez nor Kilby render obvious the combination of elements of amended Claim 1. Specifically, Claim 1 includes displaying a play of an underlying game of chance which results in a first outcome displayed to the player. The first outcome is dependent upon at least one random determination and is capable of resulting in a first payout to the player. The underlying game of chance has a first house advantage. Claim 1 also includes displaying a play of a knowledge-based bonus game using answers inputted by the player in combination with the underlying game of chance. The play of the knowledge-based bonus game results in a second outcome displayed to the player and dependent upon the knowledge of the player. The second outcome is capable of resulting in a second payout to the player. Claim 1 also includes, if the first outcome results in the first payout, the first payout is provided to the player even if the second payout is not provided to the player and if the second outcome results in the second payout, the second payout is provided to the player even if the first payout is not provided to the player. Neither Claypole, Vancura, Martinez nor Kilby render obvious this combination of elements.

Specifically, the sections referred to in Claypole refer to a first slot game that gives a player the opportunity to gamble the payout either increasing it or losing it. The player may hold some of the symbols or nudge the symbols to increase or lose the payout. Line 6 of page 2 of Claypole does not disclose providing the player the payout.

The Office Action refers on line 16, page 2 to a trail game, where if the player progresses to the end of the trail, the player may win a prize. Claypole does not render obvious an underlying game of chance that has a first outcome that may result in a first payout where the first payout is provided to the player even if the second payout is not provided to the player and if the second outcome of a knowledge-based bonus game results in the second payout, the second payout is provided to the player even if the first payout is not provided to the player.

Additionally, neither Claypole, Vancura, Martinez nor Kilby render obvious, in combination with the other elements of amended Claim 1, the knowledge-based bonus game configured to maintain within a predetermined range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, the predetermined range configured to include at least two expected returns for the player, a first expected return provided by the play of the knowledge-based bonus game by the player guessing answers and a second expected return provided by the player having perfect knowledge of answers.

Claims 8, 10, 18, 19, 25 and 88 each include if the first outcome results in the first payout, providing the first payout to the player even if the second payout is not provided to the player and if the second outcome results in the second payout, providing the second payout to the player even if the first payout is not provided to the player.

Applicant submits that for at least the reasons stated above, Claims 1, 8, 10, 18, 19, 25 88 and 88 and the claims that depend therefrom are patentable over Claypole in view of the teachings of Vancura, Martinez or Kilby and are in condition for allowance.

#### **4. The rejections over Adams in view of the teachings of Vancura, Martinez or Kilby**

Adams discloses:

[g]aming devices comprising a standard gaming unit, e.g., three reels, and a discernible additional payout indicator, e.g., a rotatable wheel. A preferred bonus payout indicator is clearly visible by the player and is actuatable when the reels of the slot machine stop on certain predetermined indicia. A preferred embodiment further comprises a payout multiplier which displays a plurality of values by which a payout may be multiplied.

According to the most preferred embodiments, a bonus payout indicator is clearly visible to a player and is operable when primary reels of a primary game slot machine stop on certain predetermined indicia. According to one preferred embodiment of the present invention, a secondary payout indicator is in the form of a rotatable bonus wheel which can be caused to spin automatically or in response to some action by a player, e.g., the player pushing a button, when the primary game indicates one of a predetermined plurality of indicia. The wheel is caused to gradually reduce speed and when the wheel stops, a pointer indicates the payout to be awarded to the player.

Another preferred embodiment of the present invention further comprises a discernible multiplier which provides the ability to change either the payout from the primary gaming unit or the secondary payout indicator, or both. As described in more detail below, it is within the scope of the present invention to provide a payout from the primary gaming unit, a payout indicated by the secondary indicator only, a payout from the primary gaming unit or the secondary indicator as changed by the multiplier, or a separate, plurality of payouts from the primary gaming unit and the secondary indicator either with or without modification by a multiplier.

While the illustrated payout multiplier of the illustrated embodiments is in the form of an electronically selected value, it is also within the scope of the present invention to have a multiplier which involves some skill on the part of a player. For example, according to an additional preferred embodiment of the present invention, a player will shoot actual projectiles, such as coins, at one or more targets in an effort to increase the value of the multiplier. In any of the embodiments of the present invention utilizing a multiplier, the multiplier can affect the value of a payout from the standard gaming unit, the additional payout indicator, or both the standard gaming unit and the payout indicator. ...

Neither Adams, Vancura, Martinez nor Kilby render obvious the combination of elements of amended Claim 1. Specifically, Claim 1 includes displaying a play of an underlying game of chance which results in a first outcome displayed to the player. The first outcome is dependent upon at least one random determination and is capable of resulting in a first payout to the player. The underlying game of chance has a first house advantage. Claim 1 also includes displaying a play of a knowledge-based bonus game using answers inputted by the player in combination with the underlying game of chance. The play of the knowledge-based bonus game results in a second outcome displayed to the player and dependent upon the knowledge of the player. The second outcome is capable of resulting in a second payout to the player. Claim 1 includes if the first outcome results in the first payout, providing the first payout to the player even if the

second payout is not provided to the player and if the second outcome results in the second payout, providing the second payout to the player even if the first payout is not provided to the player.

The multiplier of Adams may be based on the skill of a player and changes an award based on a randomly generated game outcome. The multiplier of Adams "can affect the value of a payout from the standard gaming unit, the additional payout indicator, or both the standard gaming unit and the payout indicator." Adams does not render obvious an underlying game of chance that results in a first outcome, wherein if the first outcome results in a first payout, the first payout is provided to the player even if the second payout is not provided to the player and if the second outcome of a knowledge-based bonus game results in a second payout, the second payout is provided to the player even if the first payout is not provided to the player. In Adams, the multiplier is provided as part of another award to a player. Adams does not render obvious providing an award from a skill game that results in an award separately payable to a player. In Adams, the multiplier that is earned by the skill of the player is provided to the player with another award.

Additionally, neither Adams, Vancura, Martinez nor Kilby render obvious, in combination with the other elements of amended Claim 1, the knowledge-based bonus game configured to maintain within a predetermined range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, the predetermined range configured to include at least two expected returns for the player, a first expected return provided by the play of the knowledge-based bonus game by the player guessing answers and a second expected return provided by the player having perfect knowledge of answers.

Claims 8, 10, 18, 19, 25 and 88 each include if the first outcome results in the first payout, providing the first payout to the player even if the second payout is not provided to the player and if the second outcome results in the second payout, providing the second payout to the player even if the first payout is not provided to the player.

Applicant submits that for at least the reasons stated above, Claims 1, 8, 10, 18, 19, 25 and 88 and the claims that depend therefrom are patentable over Adams in view of the teachings of Vancura, Martinez or Kilby and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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